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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,759	06/14/2000	Peter Given	2105.2130	9001

5514 7590 12/26/2002

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EXAMINER

PRATT, HELEN F

ART UNIT PAPER NUMBER

1761

DATE MAILED: 12/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/593,759

Applicant(s)

GIVEN ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-20,25 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-20,25 and 29-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4-11, 13-20, 25, 29-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 29, 32, 33-37, 72, 85 of copending Application No. 09/982,180. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '180 contain the ingredients of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-11, 13-20, 25, 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun et al. in view of Couzy and Lindon et al. and further in view of Yang et al. (2002/0146486) and Brafford et al. (6,326,038) and chart provided by Applicants. ]

The claims are rejected for the reasons of record cited in the last office action and for these further reasons. The claims require that the calcium sulfate is in the hydrated form. However, the specification discloses on page 7, 1<sup>st</sup> para. that various forms of calcium sulfate can be used, even the anhydrous form. Therefore, no patentable distinction is seen in using one form over the other. Claims 1, 4, 6, 8 and 20 have also been amended to limit the claims to "consisting of " only water and the calcium source in particular amounts. However, the specification on pages 7, 8, 9 discloses that the composition can contain other ingredients and that the composition requiring only two ingredients is a preferred embodiment. Nothing unobvious is seen in adding or removing ingredients from the composition. Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a

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patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Claim 10 further requires that the calcium source only be the hydrate form of calcium sulfate. This limitation has been addressed above.

Yang et al. disclose a low acid beverage which provides up to 850 ppm elemental calcium (abstract). The reference discusses in the "Background of the invention" that it is known that various calcium salts produce unacceptable off tastes (paragraph [007]). A particular taste is seen as being subjective, and nothing new is seen in choosing a particular compound which has a particular known flavor.

Brafford et al. disclose a process for making a calcium fortified beverage containing calcium sulfate and tricalcium phosphate. The reference recognizes that bitterness is normally associated with calcium sulfate (abstract).

As to the particular amount, Braun et al. recognize that a calcium compound could contain from 0.06 to 0.7% sulfate (col. 6, lines 54-70). This is certainly within the amount of 0.0433% (w/v) shown on applicants "calcium fortification fact sheet", given at the last interview. In addition, levels of calcium fortification are well known as provided by the Recommended Daily Amounts. It would have been within the skill of the ordinary worker to use an amount that would have provided a good taste as this involves merely adding more of the compound to a composition which is routinely done in the food

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industry to achieve a particular level of nutrient fortification, and which is routinely done in making beverages to achieve a balanced, good taste for the product.

Also, applicants provided in the last interview a chart, which contains the names of various calcium compounds and their taste and physical behavior. If this chart came from a book, it is requested that the source be provided with publication information. Certainly, this chart shows that the taste and physical behaviour of various calcium compounds is known.

The claims except for 10 are limited to "consisting of". However, it is well known to add or eliminate various ingredients to beverages to achieve a particular taste and degree of fortification, and to use various calcium compounds in beverages as shown by the combined references, and to use various calcium compounds according to their taste characteristics are known as shown by Applicants chart. Therefore, it would have been obvious to add or eliminate various ingredients, and to use particular calcium compounds. Also, it would have been obvious to use particular amounts of calcium sulfate (CS) in a composition using only CS as taught by Couzy in particularly, as disclosed by the above combination of references.

Claim 10 requires combining a ready to drink beverage with the calcium sulfate in hydrate form to make a solution and preserving the solution. This is nothing more than fortifying a beverage with a particular calcium. Braun discloses adding a calcium sulfate (anhydrous) containing mixture to orange juice. The calcium sulfate can be in the dihydrate form and the mixture is preserved i. e. pasteurized (col. 15, lines 1-10, and col. 16, lines 31-45). The particular amount is seen as being within the skill of the

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ordinary worker, as the characteristics of calcium sulfate are known (chart). Therefore, it would have been obvious to add the claim calcium containing material to a beverage in the claimed amounts.

The limitations of claims 31-34 have been discussed above and are obvious for those reasons.

### ARGUMENTS

Applicant's arguments filed 11-20-02 have been fully considered but they are not persuasive. Applicants argue that Lindon is to a mineralized drinking water, and since the claims now say consisting of, that other minerals cannot be added. However, as in claim 10, the method requires combining<sup>ins</sup> a ready to drink beverage with a calcium source. A ready to drink beverage could contain minerals. Also, the reference is used to show that the use of water soluble salts, i. e. sulfates are known.

As to Couzy, the reference does not exclude other minerals. However, it does disclose that the claimed amount of calcium is known and taken in mineral waters and is widely consumed page 1239(2<sup>nd</sup> col. , 1<sup>st</sup> para).

Applicants argue as to Braun that other calcium compounds are used and that the reference does not provide the claimed amount of RDV of calcium, or show preserving the solution. However, the references are used in combination, and nothing unobvious is seen in using the claimed calcium salt, which is routinely used in beverages by itself, as its taste characteristics are known (applicant's chart).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-

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1978. The examiner can normally be reached on Monday, Wednesday and Friday from 9:30 to 6:00 and Tues and Thurs. from 4:30 to 10 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 3959. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

Hp 12-19-02

  
HELEN PRATT  
PRIMARY EXAMINER